

REMARKS

Claims 7 through 11 were rejected under 35 U.S.C. §103 for obviousness predicated upon the acknowledged prior art (Figs. 15 through 17) in view of Saitoo et al.

In the statement of the rejection, the Examiner again concluded that one having ordinary skill in the art would have been motivated to modify the acknowledged prior art device by providing a short circuit preventing film in view of Saitoo et al., identifying films 28 in Figs. 18 and 19. This rejection is traversed as factually and legally erroneous.

There is no Motivation

As argued in the response of May 2, 2003, the Examiner is required to make a “thorough and searching” factual inquiry and, based upon that factual inquiry, explain **why** one having ordinary skill in the art would have been realistically impelled to modify particular prior art, in this case the acknowledged prior art device, to arrive at the claimed invention. *In re Lee*, 237 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). That burden has not been discharged for at least two reasons.

Firstly, the Examiner asserted that “....the purpose disclosed by Siatoo et al. would have been recognized in the pertinent art of Admitting Prior Art Figures 15-17.” (Sentence bridging pages 2 and 3 of the July 17, 2003 Office Action). But the Examiner does not follow through and identify any **facts** to support that assertion. Saying so can not make it so.

As argued in the May 2, 2003, the Court of Appeals for the Federal Circuit in *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 63 USPQ2d 1374, 1387 (Fed. Cir. 2002) emphasize the need for **facts** by stating:

The showing of a motivation to combine must be clear and particular, and it must be supported by actual evidence.

The Examiner has failed to identify any factual evidence to support the asserted motivation. In this respect, Applicants previously stressed that there is **no admission** that the **problem** addressed and solved by the claimed invention is prior art. Applicants clarified the record on page 2 of the May 2, 2003 response by stressing that the problem illustrated in the conventional device depicted in Figs. 15 through 17 represents Applicants' discovery of the problem. There was no intention to admit prior art recognition of that problem. No amount of arm twisting by the Examiner can coerce an admission where no admission was intended.

Absent any admission that the problem illustrated in Figs. 15 through 17 was known, Applicants question: **What is the factual basis to support the Examiner's assertion that the problem disclosed by Saitoo et al. "would have been recognized in the pertinent art of Admitted Prior Art Figures 15-17"?** There is no factual basis. Hence, the Examiner has **not** established the requisite motivation. *Teleflex Inc. v. Ficosa North America Corp.*, *supra*.

Secondly, the entire structure of and purpose for film 28 employed by Saitoo et al. are completely **different** from any problem which the Examiner asserts, but does not back up with facts, would have been recognized in the acknowledged prior art. Specifically, film 28 employed by Saitoo et al. comprises **stacked flat layers**, which would **not** appear to be

particular useful in preventing the short-circuiting attendant upon the prior art illustrated in Figs. 15-17. In accordance with the claimed invention, a short-circuit preventing insulating film 5 has a cylindrical shape or a pipe-like shape.

Moreover, the structure surrounding film 28 of Saitoo et al. is predetermined and fabricated without variation under defined processing conditions. Accordingly, film 28 is always effective in functioning as an insulator. There is no uncertainty. There is no unpredictability.

However, the present invention addresses a problem wherein the surrounding the structure is indefinite as to where void 9 may or may not form, and whether or not the conducting material or polysilicon 114 causes short-circuiting. Thus, the present invention is designed to solve a problem generated by two indefinite factors. The film 5 employed by the present invention solves that problem when both of these undesirable conditions occur. Not so in Saitoo et al. where everything is predictable.

Furthermore, film 5 of the present invention is meaningless if void 9 is not generated. But when void 9 is generated, it effectively functions as an insulator to prevent short-circuiting. On the other hand, in Saitoo et al., film 28 is **always** effective in functioning as an insulator because everything is predetermined.

The above argued differences in the structure and objective between Saitoo et al. and the present invention undermine the lack of motivation because of the different purpose for which the short-circuiting film of Saitoo is designed. As previously pointed out, film 28 employed by Saitoo is built into a predetermined, predesigned structure wherein it is **always** effective. However, the present invention addresses and solves an entirely different problem which, again, has not been factually established as recognized in the art. That problem is

illustrated in Figs. 15 through 17, which Applicants discovered, involves **uncertainty** as to where void 9 may or may not form and whether polysilicon 114 may or may not cause short-circuiting. The Examiner has **not** provided a **fact-based explanation why** one having ordinary skill in the art would have resorted to the predictable, predesigned structure of Saitoo et al. to address **unrecognized** problems of uncertainty in Figs. 15 through 17, even if one having ordinary skill in the art would have been presumed to be aware of such problems- and Applicants maintain the Examiner has not provided a factual basis to establish art-recognition of such a problem in the acknowledged prior art (Figs. 15 through 17). *Teleflex Inc. v. Ficosa North America Corp., supra*. Because of the unpredictability of the short-circuiting problem illustrated in Figs. 15-17, one skilled in the art would not have **assumed** existence of the same unappreciated problem as in Saitoo et al., let alone because it was not an art-recognized problem.

Conclusion

Based upon the foregoing, it should be apparent that the Examiner did not establish a prima facie basis to deny patentability to the claimed invention for lack of the requisite factual basis and want of the requisite realistic motivation. Moreover, upon giving due consideration to the problem discovered by Applicants, the conclusion appears inescapable that one having ordinary skill in the art would **not** have found the claimed invention **as a whole** obvious within the meaning of 35 U.S.C. §103. *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984).

Applicants, therefore, submit that the imposed rejection of claims 7 through 11 under 35 U.S.C. §103 for obviousness predicated upon the acknowledged prior art (Figs. 15


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through 17) in view of Saitoo et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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